

REMARKS

Status of the Claims:

Claims pending	6, 7, 8, 11-17, 20, 21, 22
Allowed claim(s):	
New claim(s):	22
Canceled claims:	
present amendment:	9, 10
earlier amendment(s):	1-5, 18 and 19
Amended claim(s):	14, 15, 17, 20 and 21

Claims 14, 15, 17, 20 and 21 have been amended to better define the invention. Claims 9 and 10 have been canceled in view of the amendment of the claim upon which they depend.

Claims 6-17, 20 and 21 stand rejected under 35 U.S.C. §112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants respectfully traverse.

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. A specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

In order to make a rejection on the basis of non-enabling disclosure, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. It is incumbent upon the Patent Office to explain why it doubts the objective truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.

In the present application, methods for making the claimed subject matter are described in general terms on pages 28-35, and a large number of specific examples are provided on pages 28-89. Methods for using the claimed subject matter are described in detail on pages 21-28. The Examiner has not provided any reasoning or evidence why a person skilled in the pertinent art

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would not be enabled to practice the claimed invention; a bare assertion by the Examiner of non-enablement is not sufficient to sustain the rejection under 35 U.S.C. §112, first paragraph. Applicants respectfully request that this ground of rejection be withdrawn.

Claims 6-9, 11, 12 and 21 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by El-Naggar. Applicants respectfully traverse.

As the Examiner pointed out, El-Naggar teaches various dibenzofuransulfonylated dipeptide methyl esters. Dibenzofuran is a tricyclic heterocyclic moiety. The claims, prior to the present amendment, encompass compounds having Cy-SO₂- group in which Cy may be heteroaryl or heterocycl. Heteroaryl and heterocycl are defined on page 18 of the specification as "mono- or bicyclic". Thus Cy does not encompass dibenzofuran, and the claims are not anticipated by El-Naggar. The present amendment further limits R¹ to specific moieties, none of which is dibenzofuran. Applicants believe that the the rejection under 35 U.S.C. §102(b) is erroneous, and respectfully request that the Examiner withdraw the same.

Claim 20 stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over El-Naggar. Applicants respectfully traverse. As noted above, El-Naggar discloses only tricyclic dibenzofuransulfonylated dipeptide methyl esters; there is no teaching or suggestion that the dibenzofuran moiety may be replaced by the various R¹ groups claimed in the instant application. Applicants respectfully submit that the Examiner has not made out a case of prima facie obviousness, and respectfully request that the 103 rejection be withdrawn.

The Examiner has maintained the previous rejection of claim 20 under 35 U.S.C. §103 over Voigt, and states that "claim 20 is currently dependent on a cancelled claim; this rejection will be maintained until such time as it becomes clear what is encompassed by claim 20." Applicants believe that this rejection has been obviated in view of the amendment made to claim 20. In the event that the rejection has not been obviated, Applicants respectfully traverse for the reasons already on record..

In view of the above amendment and remarks, Applicants believe that the application is now in condition for allowance. An early favorable action is respectfully requested.

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